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OFFICE OF PETITIONS

In re Application of :
STEPHEN BENJAMIN COURTNEY :
Application No. 10/523,246 : DECISION ON
Filed: January 27, 2005 : APPLICATION FOR
Attorney Docket No. 424662010100 : PATENT TERM ADJUSTMENT

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 USC 154(b)(2)(A), filed June 26, 2009, which is properly treated under the provisions of 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand ninety-eight (1,098) days, not eight hundred one (801) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent.

To the extent that instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR

1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

With respect to applicants' other basis for filing this paper, the application for patent term adjustment is **DISMISSED**.

On June 2, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

¹ For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(PTA) to date is 801 days. On June 26, 2009, applicants timely submitted the instant application for patent term adjustment before payment of the issue fee.

Applicants dispute the reduction of 15 days for the filing of an Information Disclosure Statement (IDS) on October 2, 2008. Specifically, applicants assert:

[T]he PTO's reduction of the PTA by 15 days due to Applicant's alleged delay between September 17, 2008 (date of Applicant's response to the Office Action) and October 10, 2008 (date of an IDS) is improper. Applicant's response of September 17, 2008 was timely filed within three months of the mailing date of the Office Action, which is June 20, 2008. Therefore, Applicant's PTA should not be reduced under 35 USC 154(b)(2)(C)(ii).^[2] The response is docketed out of order in the PTO patent term adjustment history appearing in PAIR, which may have caused the calculation error.

Request filed 06/26/09, p. 2.

The Office concurs with applicants that they filed a reply on September 17, 2008, within three months of the mailing of the non-final Office action on June 20, 2008, and therefore, are subject to reduction under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). The Office notes that a delay under 37 CFR 1.704(b) was not assessed against applicants. Rather, the basis for the 15 day reduction for the filing of the IDS on October 2, 2008, is pursuant to 37 CFR 1.704(c)(8), not 37 CFR 1.704(b).

It is undisputed that after filing the reply on September 17, 2008, applicants submitted a supplemental reply or other paper in the form of an IDS on October 2, 2008. The record does not support a conclusion that the examiner expressly requested the filing of the IDS. Further, a review of the IDS, filed October

² 35 U.S.C. (b)(2)(C)(ii) states:

With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

2, 2008, reveals that applicants did not include a proper statement under 37 CFR 1.704(d).³ Thus, under the circumstances of this application, the submission of the IDS on October 2, 2008, is a proper basis for reduction of patent term adjustment pursuant to 37 CFR 1.704(c)(8).

37 CFR 1.704(c)(8) states:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

In this instance, the period of adjustment was properly reduced by 15 days, counting the number of days beginning on the day after the date the initial reply was filed, September 18, 2008, and ending on the date that the IDS was filed, October 2, 2008. See 37 CFR 1.704(c)(8). Accordingly, the period of reduction of 15 days will remain.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains 801 days.

The Office will charge the Deposit Account for the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b), as authorized.

³ Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

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